

REMARKS

The last Office Action has been carefully considered.

It is noted that the claims 10-18 are rejected under 35 U.S.C. 102(b) over the U.S. patent application publication to Sato, et al.

Claims 10-18 are rejected under 35 U.S.C. 102(b) over the U.S. patent to Takayama.

Claims 10-18 are rejected under 35 U.S.C. 102(b) over the U.S. patent to Song, et al.

Claims 10-18 are rejected under 35 U.S.C. 102(b) over the U.S. patent to Katoh.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, claims 10 and 18, the broadest method and apparatus claims, have been amended to more clearly define the present invention and to distinguish it from the prior art.

Before the analysis of the prior art, it is believed to be advisable to explain to the Examiner the new features of the present invention.

In accordance with the present invention, for operating an internal combustion engine a flow of fuel mass entering an engine oil is first determined, then a flow of fuel mass evaporating out of oil is determined, and a setpoint injected-fuel quantity is determined taking into account the previously determined flow of fuel mass evaporating out of oil.

Turning now to the references and particularly to the Sato reference, it can be seen that this reference discloses a combustible-gas sensor, a diagnostic device for intake-oxygen concentration sensor, and air-fuel ratio control device for internal combustion engines. The reference deals with a diagnosis of an oxygen concentration sensor in a suction pipe in an intake pipe, which measures the HC concentration through the tank ventilation. It is plausibelized with the output of the lambda probe in the exhaust line.

The method and the control unit in accordance with the present invention as defined in amended claims 10 and 18 has nothing to do with a sensor in a suction pipe. The present invention the method and the control unit of the present invention has nothing to do with a tank ventilation (purge), but instead it deals with a crankshaft ventilation. This reference does not teach the new features of the present invention which are now defined in amended claims 10 and 18.

The patent to Takayama discloses an engine control with a positive crankcase ventilation which has a relation to the applicant's invention, in that it also deals with a crankcase ventilation. In accordance with the method disclosed in this reference the blowby gas is detected by means of the feedback signal of the lambda control and compensated during the calculation of the injection quantity. This reference however does not disclose the determination, during operation of the internal combustion engine, of a flow of fuel mass entering an engine oil with the subsequent determination of the flow of fuel mass evaporating out of oil, but instead in the patent to Takayama the control is performed via the feedback of the probe.

This reference also does not teach the new features of the present invention as now defined in amended claims 10 and 18.

The patent to Katoh deals with an engine management system. It discloses a two-cycle internal combustion engine and a solution to avoid accumulation of dirt and fuel. This reference does not disclose the above explained new features of the present invention as now defined in claims 10 and 18.

Finally, the patent to Song discloses a computer control engine valve operation. It has nothing to do with ventilation from the crankcase. The present invention deals with a variable valve drive (determination of filling

degree/control, residual gas). This reference takes into consideration only the tank ventilation or, in other words, purge fuel.

This reference also does not teach the new features of the present invention as defined in claims 10 and 18.

It is believed to be clear that the new features of the present invention which are now defined in the amended claims 10 and 18 are not disclosed in the references applied by the Examiner against the original claims.

The claims were rejected over the references as being anticipated. In connection with the anticipation rejection, it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the references do not disclose each and every element of the present invention as now defined in amended claims 10 and 17.

It is therefore respectfully submitted that the anticipation rejection of the original claims over the reference should be considered as not tenable with respect to amended claims 10 and 16 and should be withdrawn.

The present invention as defined in amended claims 10 and 16 also can not be considered as obvious from the references. The references do not contain any hint or suggestion for the new features of the present invention as defined in the amended independent claims. In order to arrive at the applicant's invention the references have to be fundamentally modified by departing from their concepts and introducing into them the new features of the present invention as first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals, which for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments, it is believed that claims 10 and 16 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 10, they share its presumably allowable other features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

/ Michael J. Striker /

Michael J. Striker
Attorney for Applicant
Reg. No. 27233